



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of )

Joel L. PASSKE, et al. )

Serial Number 09/887,523 ✓ )

Filed: June 21, 2001 )

For: FOOTWEAR WITH BLADDER FILTER )

Group Art Unit: 3728

Examiner: Stashick, A.

Attorney Reference: 005127.00094

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Brief  
C. J. Smith  
9/30/03

**REPLY BRIEF**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Alexandria, VA 22313

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Sir:

In reply to the Examiner's Answer, mailed August 19, 2003, Appellants respectfully submit this Reply Brief in the above-captioned appeal to the Board of Patent Appeals and Interferences.

*First Issue - No Proper Motivation to Combine Reed and Opal*

Appellants continue to maintain, contrary to the assertions presented in the Examiner's Answer, that there is no proper motivation to combine U.S. Patent Number 5,845,417 to Reed et al. (hereafter referred to as Reed) and European Patent Application Number 1,074,193 to Opal Limited (hereafter referred to as Opal).

Reed specifically states that "[m]oisture and liquid, along with air, may be drawn through the filter 214 and into the pump cell" (Reed, column 8, lines 48-49). In addition, Reed states that "air is drawn through the filter and into the inlet of intake tube 258. The air and/or liquid then passes through intake valve 264 and through the monotube 260 into the pump cell 254" (Reed, column 10, lines 4-7). The filter disclosed in Reed expressly permits, therefore, the passage of

liquids. Opal discloses a waterproof, breathable membrane material that is merely incorporated into the upper of an article of footwear.

The Examiner asserts that it would be obvious to replace the filter of Reed with the material of Opal. Reed expressly incorporates a filter that permits the passage of liquids because “it is very difficult to remove moisture and the odor produced as a result of moisture which collects in the shoe due to foot sweating caused by poor shoe ventilation” (Reed, column 1, lines 24-30). Utilizing the waterproof material of Opal would prevent the invention of Reed from operating to remove water from the shoe. Accordingly, utilizing the waterproof material of Opal would render Reed unsatisfactory for its intended purpose of removing liquids, such as water. Accordingly, a *prima facie* case of obviousness has not been established because no proper motivation exists to combine Reed with Opal in the rejection of claims 1-16.

*Second Issue - No Proper Motivation To Combine Colesnicenco and Opal*

Appellants continue to maintain, contrary to the assertions presented in the Examiner’s Answer, that there is no proper motivation to combine French Patent Application Number 2,670,369 to Colesnicenco Niculae (hereafter referred to as Colesnicenco) and Opal.

Colesnicenco teaches a mechanical ventilation system that includes an “air filter”, rather than an air and/or liquid filter (Colesnicenco translation, page 3, lines 13 and 20, and the Abstract). Furthermore, Colesnicenco teaches that the air filter consists of “a filtering material (1b) such as felt or another filtering material” (Colesnicenco translation, page 3, lines 20-22). As stated above, Opal discloses a waterproof, breathable membrane material that is merely utilized in the upper of an article of footwear.

The Examiner asserts that it would be obvious to replace the air filter of Colesnicenco with the material of Opal. Colesnicenco discloses an air filter. Without providing further support, the arguments in the Examiner’s Answer assert that the air filter (felt or another filtering material) would restrict the passage of liquids. Given that the filter is specifically disclosed as an air filter, however, there is no teaching to support the proposition that the waterproof, breathable membrane of Opal would be an obvious replacement for the air filter material.

As a separate matter, Colesnicenco teaches a fluid system for mechanically-ventilating footwear that incorporates conduits, pumps, and valves to forcefully transfer air. In contrast, Opal merely teaches the diffusion of air through the waterproof, breathable membrane and from

the interior of the footwear to the exterior, and vice-versa. The fact that the waterproof, breathable membrane of Opal may be utilized in footwear is not sufficient to suggest to one skilled in the art that the material may be given a specialized purpose in a complex mechanical system that pumps air into the upper.

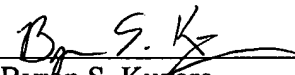
For the reasons discussed above, Applicants submit that there is no suggestion or motivation to make the proposed modification of Colesnicenco with the material disclosed in Opal. Accordingly, the Examiner has not properly established the *prima facie* case of obviousness in the rejection of claims 1-14 and 16.

### *Conclusion*

The rejections submitted in the Office Action of February 26, 2003 and reiterated in the Examiner's Answer of August 19, 2003 should be reversed for at least the reasons recited above. Allowance of claims 1-16 is, therefore, respectfully requested.

Appellants submit this Reply Brief in triplicate to the Board of Patent Appeals and Interferences. It is believed that no fees are due in connection with this Reply Brief. Should additional fees be deemed necessary, however, such fees are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee.

Respectfully submitted,

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